

REMARKS

Claims 36-44 are at issue. No claims have been allowed.

Claim 44 has been objected to because, as written, it was dependent from itself.

Applicant has amended claim 44 whereby it now depends from claim 43.

Claims 40 and 44 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Sliwiak, U.S. Patent No. 2,671,951, and Steiner, U.S. Patent No. 5,627,424.

Sliwiak teaches a rectangular winding leg stack 14 with interlocking extrusions 20 (tabs and slots). Each of the laminations or winding leg 14 is identical in shape.

Steiner teaches a cylindrical stack 7 which forms a side leg of a core, one end of the side leg includes tabs 39 and the other end includes slots 41. No interlocks are shown for interlocking the laminations into a stack.

The Examiner has indicated that it would have been obvious to a person of ordinary skill in the art at the time of the invention to construct the core of Sliwiak with the protrusion or groove of Steiner to provide a low cost and improved method of production.

Amended claim 40 calls for a first elongate rectangular slender relatively flexible planar lamina having first and second opposed edges defining the narrow ends of the rectangular lamina and a second elongate rectangular slender relatively flexible planar lamina which is of the same length of the first lamina but of a width which is different from the width of the first lamina, the first and second edges of the first and second lamina aligned to define essentially planar surfaces, both of the substantially planar surfaces provided with a groove which is substantially perpendicular to the first and second directions.

Sliwiak does not disclose a stack wherein one of the elongate rectangular slender relatively flexible laminae has a different width than a second such lamina. Steiner shows laminae of different widths but does not show interlocks in such laminae.

As fully described in Applicant's application, it is difficult to interlock long slender laminae of different widths in a die, i.e., when the laminae do not have identical widths as shown in Sliwiak. While the prior art is old, no one has invented a stack as claimed by Applicant.

The Examiner's contention that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to construct the core of Sliwiak with a protrusion or groove of Steiner to provide a low cost and improved method of production and

Application No. 10/022,599  
Amendment dated June 16, 2003  
Reply to Office Action dated February 14, 2003

that Applicant's claimed invention is therefore obvious is incorrect. The Examiner has shown nothing whatsoever as a source of motivation or suggestion to combine the references. Neither of the two cited references discloses anything to motivate one to combine their teachings. One of the references teaches an interlocked stack of equally dimensioned laminae. The other reference shows a cylindrical stack which is held together by an unspecified method.

Applicant has amended claim 40 whereby it now calls for grooves in both end surfaces of the stack. This is not shown by Steiner. Steiner's purpose for using tabs 39 and slots 41 is entirely different than Applicant's. In Steiner, the tabs and slots are used to interlock the legs of the remainder of the core. In Applicant's invention, the grooves are used to guide the difficult to guide slender laminae to their proper positions in the stack.

Applicant's specification points out the difficulties of manufacturing a long slender interlocked stack wherein the laminae have different widths.

There is a substantial body of case law regarding the need by an examiner to show motivation for one skilled in the art to combine references. The Federal Circuit has recently stated:

"This court has explained the purpose of the motivation to combine requirement:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the [challenger] to show a motivation to combine the references that create the case of obviousness. In other words, the [challenger] must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. This court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.

*In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)." Beckson Marine, Inc. v. NFM, Inc., 292 F.3d 718, 727-728 (Fed. Cir. 2002).

"The first requirement is that a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential evidentiary component of an obviousness holding.' *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)." Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1125 (Fed. Cir. 2000).

Application No. 10/022,599  
Amendment dated June 16, 2003  
Reply to Office Action dated February 14, 2003

"As this court has stated, 'virtually all [inventions] are combinations of old elements.' Therefore, an examiner [or accused infringer] may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner [or accused infringer] to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention . . . . To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. *In re Rouffet*, 149 F.3d 1350, 1357-58, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (internal citations omitted)." *Yamanouchi Pharmaceutical Co., Ltd. v. Danbury Pharmacal, Inc.*, 231 F.3d 1339, 1343 (Fed. Cir. 2000).

As stated in *In re Rouffet*, the Court requires that some motivation to combine the references be shown to create a case of obviousness. In other words, the Examiner must show reasons that the skilled artisan confronted with the same problems as the inventor, and with no knowledge of the claimed invention, would select certain elements from the cited prior art references for combination in the manner claimed. A simple assertion by the Examiner is insufficient. Further, the *In re Rouffet* court stated that virtually all inventions are combinations of old elements. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Applicant submits that the Examiner has used the claimed invention as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. The Examiner should show a motivation or suggestion to combine the teachings of the prior art to arrive at Applicant's invention.

Claim 43, from which claim 44 depends, calls for a stack formed by a process. There is nothing whatsoever in the two cited references to disclose the product formed by the process as claimed.

In view of the foregoing, Applicant respectfully submits that claims 40 and 44 (which depends from claim 43) distinguish patentably over the cited references.

Claims 36, 37, 41, 42, and 43 have been rejected under 35 U.S.C. 103 as being unpatentable over Sliwiak and Steiner in further view of Merlano (U.S. Patent No. 5,671,526) and Burns (U.S. Patent No. 1,182,636).

Sliwiak and Steiner have been discussed hereinabove.

Merlano teaches a stack of long slender, identically shaped, laminas which are interlocked by means of interlocking tabs 5. Merlano also teaches that the end lamination does not have a tab.

Burns discloses a cylindrical core 41 in which the laminas are secured by rivets 43.

Claim 36 calls for an elongate cylindrical stack of laminae comprising at least one first lamina and a second lamina, each lamina having a rectangular shape having a width and a length wherein the first lamina is the widest of all lamina in the stack wherein the second lamina has a width which is less than the width of the first lamina, each lamina having two interlocked slots for interlocking interference engagement except for the top lamina and the bottom lamina, the stack having two substantially planar end surfaces defined by the narrow ends of the laminae, both planar surfaces include a groove which extend substantially perpendicularly to the widths and the lengths.

As in connection with a rejection of claim 40, above, Applicant submits that the Examiner has pointed to nothing whatsoever whereby the four references can be combined and whereby that combination results in Applicant's invention. Applicant submits that the Examiner has used hindsight, based on Applicant's invention, to defeat the patentability of Applicant's invention. There is nothing whatsoever in the nature of the problem to be solved, the teachings of the prior art, or the knowledge of persons of ordinary skill in the art, to arrive at Applicant's invention. Applicant's specification clearly describes the difficulty of assembling a cylindrical stack as described and interlocking that stack by means of slots and tabs, and which argues against obviousness.

Steiner does not describe interlocks, Sliwiak and Merlano show stacks comprised of identically shaped laminas, and Burns shows a cylindrical stack which employs rivets to keep the laminas engaged with one another. If anything, the references teach away from Applicant's invention. For instance, by combining Burns and Steiner, Steiner would use rivets to secure his stack of laminas. By referring to Sliwiak and Merlano, one of ordinary skill in the art would think that a stack of long slender laminas could be interlocked only if all laminas had identical shapes. Applicant therefore respectfully submits that claims 36 and 40 and the claims which depend therefrom are in condition for allowance.

Similarly, claim 43 calls for an elongate stack made with a process of interlocking laminas of different widths to form a cylindrical stack of laminae and to accomplish that

Application No. 10/022,599  
Amendment dated June 16, 2003  
Reply to Office Action dated February 14, 2003

process in a die assembly. There is nothing whatsoever in any of the references which teach that process nor a product manufactured with that process.

Applicant therefore respectfully submits that claim 43 distinguishes over and is not obvious in view of the cited references.

Claims 38 and 39 have been rejected under 35 U.S.C. 103 as unpatentable over Sliwiak, Steiner, Merlano, Burns, and further in view of Allen et al. (U.S. Patent No. 5,777,537. Claims 38 and 39 both depend from claim 36 and therefore include all the limitations of claim 36.

Sliwiak, Steiner, Merlano, and Burns have been discussed hereinabove.

Allen et al. add nothing to the disclosures of Sliwiak, Steiner, Merlano, or Burns to overcome the problems with those references pointed out hereinabove. Allen et al. do teach laminae formed as a flat layer from highly grained oriented silicon steel and wherein the various pieces of the lamination that make up the magnetic paths are configured so that the grain direction coincides with the flux path. However, Allen et al. do not correct any of the shortcomings of the other four applied references. In view of the foregoing, Applicant respectfully submits that claims 38 and 39 distinguish patentably over the cited prior art and are in condition for allowance.

Applicant notes that the double patenting rejection of claim 36-39 has been withdrawn.

For the above reasons, Applicant submits all claims at issue are in condition for allowance and respectfully requests allowance thereof.

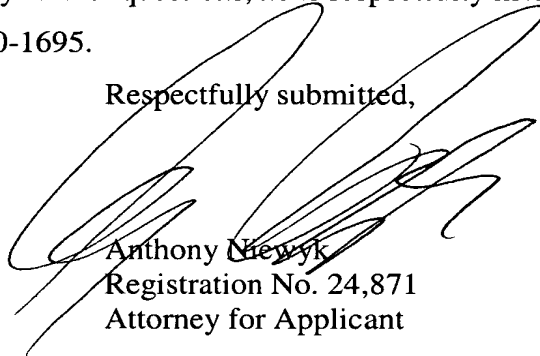
In the event Applicant has overlooked the need for an additional extension of time, payment of fee, or additional payment of fee, Applicant hereby petitions therefor and authorizes that any charges be made to Deposit Account No. 02-0385, Baker & Daniels.

[THIS SPACE INTENTIONALLY LEFT BLANK]

Application No. 10/022,599  
Amendment dated June 16, 2003  
Reply to Office Action dated February 14, 2003

Should the Examiner have any further questions, he is respectfully invited to telephone the undersigned at 260-460-1695.

Respectfully submitted,

A large, stylized handwritten signature in black ink, appearing to read 'Anthony Newyk', is written over the typed name and registration information.

Anthony Newyk  
Registration No. 24,871  
Attorney for Applicant

AN/mh

BAKER & DANIELS  
111 East Wayne Street, Suite 800  
Fort Wayne, IN 46802  
Telephone: 260-424-8000  
Facsimile: 260-460-1700  
Encs. - Petition For Extension Of Time  
Check No. 109499  
Postcard